



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/867,587 | 05/31/2001 | Bill Kitchen | 3350-05E | 8050 |
| 20457 | 7590 | 07/28/2004 | EXAMINER | |
| ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-9889 | | | ALVAREZ, RAQUEL | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3622 | |

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/867,587
Filing Date: May 31, 2001
Appellant(s): KITCHEN ET AL.

MAILED

JUL 28 2004

GROUP 3500

Alfred A. Stadnicki
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/3/2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because some of the claims have the same elements and therefore should be grouped together. The grouping should be as follows:

Claim 34 stand and fall by itself.

Claim 35 stand and fall by itself.

Claim 36 stand and fall by itself.

Claims 37-38 stand and fall together.

Claim 40 stand and fall by itself.

Claim 41 stand and fall by itself.

Claim 42 stand and fall by itself.

Claim 51 stand and fall by itself.

Claim 43 stand and fall by itself.

Claim 44 stand and fall by itself.

Claim 45 stand and fall by itself.

Claims 46-47 stand and fall by itself.

Claim 49 stand and fall by itself.

Claim 50 stand and fall by itself.

Claim 52 stand and fall by itself.

Claim 53 stand and fall by itself.

Claims 39 and 48 stand and fall by itself.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

| | | |
|-----------|--------------|---------|
| 5,699,528 | Hogan | 12-1997 |
| 6,029,141 | Bezos et al. | 2-2000 |

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 34-38, 40-47 and 49-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Hogan (5,699,528 hereinafter Hogan).

With respect to claim 34, Hogan teaches a method for presenting billing information (Abstract). Transmitting a notice according to an e-mail protocol via a network, indicating availability of billing information (i.e. the user receives an e-mail through a mail server via a network to bring a bill to the subscriber's attention; the e-mail containing the URL of the bill service company) (col. 5, lines 53-61); transmitting a request according to a protocol other than e-mail protocol, via the network, to receive the billing information responsive to receipt of the notice (i.e. the user via a web server connects to the bill service site by clicking on the URL of the particular bill service company to view the content of the billing information) (col. 4, lines 14-22 and col. 5, lines 44-, col. 6, lines 1-30); transmitting at least a portion of the billing information, via the network, responsive to receipt of the request (i.e. the user receives the billing information pertaining to the user's requests via the web) (col. 6, lines 11-30).

With respect to claim 35, Hogan further teaches formatting the billing information for presentation responsive to receipt of the request (see Figure 11).

With respect to claim 36, Hogan further teaches formatting the billing information for presentation prior to transmitting the notice (i.e. device 150 collects and processes bill images from participating payees, and the images are created prior to sending the bill notice to the customer (col. 4, lines 53-67); storing the formatted billing information (i.e. the formatted billing information is stored and transmitted from device 150 to the server which would allow the user to access their bill information)(col. 5, lines 1-10); wherein the transmitted billing information is the stored formatted billing information (col. 5, lines 1-10 and col. 9, lines 50-54).

With respect to claims 37-38, Hogan further teaches that the notice includes information indicating a location of the available information is a hyperlink and selecting the hyperlink to transmit the request (i.e. the e-mail message received by the user contains a web site location (hyperlink) and the user selects the hyperlink to transmit his interest in viewing the billing information)(col. 4, lines 14-22 and col. 5, lines 44-, col. 6, Lines 1-30).

With respect to claims 40, Hogan teaches a method for transmitting billing information (Abstract). Transmitting, via the a network, an e-mail notice indicating availability of billing information (i.e. the user receives an e-mail over network 100 containing a message header about stored electronic bills)(Figure 1 and col. 9, lines 7-19); transmitting, via the network, an e-mail request to receive the billing information responsive to receipt of the notice (i.e. an acknowledgement message through network

Art Unit: 3622

110 is sent indicating the user's request to receive the billing information)(col. 9, lines 61-64) and transmitting, via the network, at least a portion of the billing information responsive to receive of the request (i.e. the billing information responsive to the user's request is transmitted to the user)(see Figures 10-11).

With respect to claim 41, is similar in scope as claim 35 rejected above and therefore is rejected under similar rationale.

With respect to claim 42, is similar in scope as claim 36 rejected above and therefore rejected under similar rationale.

Claim 51 is substantially similar to claim 40 and therefore is rejected under similar rationale.

With respect to claim 43, Hogan teaches a method for presenting billing information (Abstract). Transmitting, via a network, a notice indicating availability of billing information, the notice transmitted according to a network other than e-mail (i.e. When the user visits the bill payment web site and enters the correct userID and password, the user receives a display indicating the availability of stored billing information) (Figure 3 and col. 6, lines 9-16); transmitting, via the network, a request to receive the billing information responsive to receipt of the notice, the request also transmitted according to a protocol other than e-mail (i.e. the user selects the EBSC's

Art Unit: 3622

bill payment web site to request the billing information (col. 5, lines 62- , col. 6, lines 1-30); and transmitting, via the network, at least a portion of the billing information responsive to receipt of the request (i.e. the billing information responsive to the user's request is transmitted to the user)(col. 6, lines 11-30).

With respect to claim 44 is similar in scope as claims 35 and 41 therefore rejected under similar rationale.

With respect to claim 45 is similar in scope as claims 36 and 42 and therefore rejected under similar rationale.

Claims 46-47 are similar in scope as claims 37-38 rejected above and therefore rejected under similar rationale.

With respect to claim 49, Hogan further teaches that the second network protocol is the same as the first network protocol (i.e. the transmission of the notice and the response to the notice are being conducted through the Internet network)(see Figure 1).

Claim 50 is similar in scope as claim 34 rejected above and therefore rejected under similar rationale.

Claim 52 is similar in scope as claim 43 rejected above and therefore rejected under similar rationale.

Claim 53 is similar in scope as claim 49 rejected above and therefore rejected under similar rationale.

Claims 39 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over of Hogan (5,699,528 hereinafter Hogan) in view of Bezos (6,029,141 hereinafter Bezos).

With respect to claims 39 and 48, the claims further recite that the hyperlink is an icon. Hogan teaches that the hyperlink is an URL. Hogan does not specifically teach that the hyperlink is an icon. On the other hand, Bezos teaches an Internet-based customer referral system wherein the hyperlink is a graphic icon 600 which allows the customers to click on the icon with a mouse in order to link to a web site (Figure 6, item 600). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the hyperlink of Hogan to be an icon as taught by Bezos because such a modification would allow for the users to see a visual representation of the hyperlink.

(11) Response to Argument

The Applicant argues that the e-mail of Hogan is not a notice of availability of billing information rather a notice to inform subscriber of a pending bill due date. The recited claims do not exclude that the bill can't be sent in the e-mail. In addition, in Hogan the e-mail is sent from server computer 160, the server computer 160 having access to subscriber billing data. The e-mail received contains certain information on the bill that is due and instruct the customer on how to access the bill payment data through server computer 160 in order for the customer to receive additional information on the bill that is due by instructing the customer to log into the EBSC's bill payment website (col. 5, lines 62-, col. 6, lines 1-31). The notice of the bill due is in essence, billing data on the bill that is due and therefore the claim limitation has been met. The Appellant is reminded that the two embodiments of Hogan is part of the same reference and should be considered as a whole.

Applicant argues that Hogan discloses a single server for all communications with subscribers. The Examiner respectfully disagrees with Applicant because Hogan teaches an Internet based system and as such an Internet based system enables different servers such as local servers, global servers, email servers, etc. In addition, Hogan teaches the subscribers communicating with the system through e-mail server and through web servers.

Appellant argues that Figure 9 of Hogan teaches sending billing information but that it doesn't teach a notice of availability of billing information. The Examiner doesn't understand how Hogan can teach sending billing information but not the notice of

available billing information. Figure 9, item A clearly teaches sending a notice of bills information that can be viewed and paid.

Appellant argues that Hogan doesn't teach request for billing information in association with the e-mail embodiment. The Examiner disagrees with Appellant because when the subscriber opens the e-mail in essence his or she is requesting to receive the bill information (col. 9, lines 61-63).

With respect to Figures 10 and 11, the Examiner wants to point out that after the subscribers open the e-mail and request to receive the billing information then the subscribers will be presented with Figure 9 in which he or she can elect to view and pay his or her bills. Depending on the subscribers election then Figure 10 and 11 will be presented to the subscribers.

With respect to the interpretation of Figure 3, the Examiner agrees with the Applicant that Figure 3 depicts a home page of the bill service presented via the World Wide Web. The Examiner wants to point out that the network protocol is the Internet (World Wide Web) which is a network other than the e-mail network. Detail 203 links the user to the available billing information. The Examiner respectfully disagrees with Applicant that Hogan doesn't teach in Figure 3 a notice of available bill information. The Examiner asserts that a notice is merely used to bring attention to a particular subject. In Figure 3 all the detail items 201, 203, 205, 207, 209 and 211 are all notices or subject which are brought to the user's attention such as item 203 which brings to the subscriber attention the available bills.

The two embodiments of Hogan are part of the same reference and therefore are combinable to make a whole.

With respect to "in response of the request of the billing information formatting the bill". The claim doesn't recite that the bill is formatted on the fly. The claim limitation is met by Hogan because in Hogan the user receives an e-mail reminder of the bill that is due and the user is instructed to visit the EBSC website and based on the user requesting the bill information from the website the bill is formatted and presented to the user (col. 5, lines 62-, col. 6, lines 1-31).

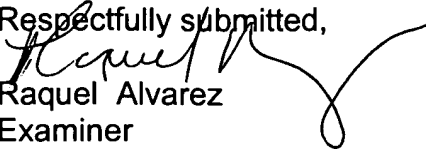
Appellant argues that Hogan doesn't teach a location identifier of available billing information. The Examiner disagrees with Appellant because Hogan clearly teaches a subscriber receiving an URL/hyperlink of the EBSC's website which contains available billing information (col. 5, lines 62 to col. 6, lines 1-31).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Hogan teaches available billing information and Bezos teaches displaying a hyperlink as an icon to indicate a particular location containing the specified information (Figure 6, item 600) therefore the combination of Hogan and Bezos teach a location of available billing information (in Hogan) being an icon (in Bezos). Both references are solving the same particular problem of identifying a particular location that contains the specified information.

Art Unit: 3622

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Raquel Alvarez
Examiner
Art Unit 3622



R.A.

July 23, 2004

Conferees

James Myhre 

Eric Stamber 

Alfred A. Stadnicki
Fifth Floor
1146 Nineteenth Street, NW
Washington, DC 20036